

Applicant: David Qiang Meng
Serial No. : 10/750,423
Filed : December 30, 2003
Page : 6 of 8

Attorney Docket No.: 10559-914001 / P16854

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REMARKS

In response to the Office Action mailed on June 27, 2006, Applicants amended claims 1-8 and 11. Claims 1-26 are presented for examination.

The examiner has rejected claims 1-26 under 35 U.S.C. 112, first paragraph as failing to comply with the enablement requirement. The examiner states that "[t]he specification does not disclose how a memory device is partitioned to produce the groups recited in claim 1."¹ The applicant disagrees.

The examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.² A patent need not teach, and preferably omits, what is well known in the art.³ The amount of guidance or direction needed to enable the invention is inversely related to the amount of knowledge in the state of the art as well as the predictability in the art.⁴ The "amount of guidance or direction" refers to that information in the application, as originally filed, that teaches exactly how to make or use the invention. The more that is known in the prior art about the nature of the invention, how to make, and how to use the invention, and the more predictable the art is, the less information needs to be explicitly stated in the specification.

According to the applicant's specification:

Each of the entries in CAM 54 is configurable by a CAM manager 58 that is implemented as microcode in the control store 50 and, which is executed by the packet engine 48. The CAM manager partitions the CAM 54 into a particular number of entries.⁵

¹ Office Action, page 2

² In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).

³ In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

⁴ In re Fisher, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

⁵ Applicant's specification, page 9, lines 18-22.

Applicant : David Qiang Meng
Serial No. : 10/750,423
Filed : December 30, 2003
Page : 7 of 8

Attorney's Docket No.: 10559-914001 / P16854

Pages 9-17 provide further details and examples of how the CAM is configured by the CAM manager 58. Thus, upon reading the application as originally filed, the application would enable one skilled in the art to make and use the same. The application as originally filed provides clear guidance regarding the partitioning of a content addressable memory. Accordingly, Applicants contend that the rejection under 35 U.S.C. § 112, first paragraph is improper and should be removed.

The Examiner also rejected claims 1-26 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. However, the application as originally filed disclosed an embodiment of a method covered by claims 1-9, an embodiment of a computer program product covered by claims 10-14, an embodiment of a CAM manger covered by claims 15-17, an embodiment of a system covered by claims 18-20, and an embodiment of a packet forwarding device covered by claims 20-26. Therefore, the rejection of claims 1-26 under 35 U.S.C. § 112, first paragraph should be withdrawn.

The Examiner also rejected claims 1-26 under 35 U.S.C. § 101 for lack of utility. The examiner stated:

As stated in the specification at page 11, line 19 through page 12, line 1, an un-configurable CAM is not capable of performing the claimed functions. As there is no disclosure of a configurable CAM, the disclosed invention is inoperative and therefore lacks utility.⁶

The applicant disagrees, the portion of the specification to which the examiner refers states:

By allowing CAM 54 to load different data types (e.g., MAC addresses, IP addresses) into each CAM entry and to select which data type to use to determine a potential match, the CAM can be loaded during one time period with two or more different data types compared to loading the CAM multiple times with different data types for separate parallel comparisons in an un-configurable CAM.

The portion of the specification to which the examiner refers describes the advantage of partitioning the memory of a configurable CAM in comparison to using an un-configurable CAM.

In addition, applicant again refers the examiner to the above quoted paragraph describing that the CAM is configured by a CAM manager 58 that is implemented as microcode in the

⁶ Office Action, page 9

Applicant : David Qiang Meng
Serial No. : 10/750,423
Filed : December 30, 2003
Page : 8 of 8

Attorney's Docket No.: 10559-914001 / P16854

control store 50. Accordingly there is a disclosure of a configurable CAM and applicant's specification discloses a utility and therefore, the rejection of claims 1-26 under 35 U.S.C. § 101 should be withdrawn.


The Examiner also rejected claims 1-14 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Without conceding the appropriateness of the rejection, and solely to advance this application to issuance, Applicants have amended the claims as shown above, the applicant has amended independent claims 1 and 8 and claims 2-7 and 9-14 depend on claims 1 and 8, respectively. Accordingly, Applicant requests that the rejection of claims 1-14 be withdrawn.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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